

REMARKSRejection of Claims of Art Grounds in the 05 January 2005 Office Action, andTraversal Thereof

In the 05 January 2005 Office Action, claims 1, 5-9, 12-19, 23-24, 27-32, 36-40, 43-50, 54-55, 58-63, 66-67 and 70 stand finally rejected under 35 U.S.C. 102(e) as being anticipated by Carpenter-Smith (U.S. 5,838,973). Claims 2-4, 10-11, 20-22, 25-26, 33-35, 41-42, 51-53, 56-57, 64-65 and 68-69 stand finally rejected under 35 U.S.C. 103(a) as being unpatentable over Carpenter-Smith (U.S. 5,838,973) in view of Mutschler (U.S. 6,381,743).

The above rejections of the claims 1, 5-9, 12-19, 23-24, 27-32, 36-40, 43-50, 54-55, 58-63, 66-67 and 70 are traversed, and consideration of the patentability of claims 2-4, 10-11, 20-22, 25-26, 33-35, 41-42, 51-53, 56-57, 64-65 and 68-69, as amended, is requested in light of the ensuing remarks.

The Present Invention Is Novel Over Carpenter-Smith (U.S. Patent No. 5,838,973)

As stated in MPEP §2131, a claim is anticipated under §102 only if each and every element as set forth in the claim, in as complete of detail, is found in a single prior art reference. The claimed invention, according to the currently amended independent claims, includes recitations for automatically executing the claimed process steps. Carpenter-Smith does not disclose the automated process of the present invention. Instead, Carpenter-Smith discloses a computerized modeling system that "guides the user through the object-oriented design process." Therefore, Carpenter-Smith cannot anticipate the present invention as presently claimed. Support for the current amendments can be found as original in paragraphs [0019], [0020], [0059], and [0118] of the present application. Therefore, no new matter has been added by this amendment.

The Present Invention Is Not Obvious Over The Cited References

A claimed invention may be found to have been obvious "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103(a). Moreover, the Federal Circuit has ruled on numerous occasions that a holding of "obviousness" requires some motivation, suggestion or teaching within the cited references that would lead one skilled in the art to modify the cited reference or references as claimed by applicant. See, for example, *In re Kotzab*, 217 F.3d 1365, 55 USPQ2d 1313 (Fed Cir. 2000):

"Most if not all inventions arise from a combination of old elements. See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See *B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996)."

The cited Carpenter-Smith patent and the cited Mutschler patent describe software tools. The invention described by Carpenter-Smith is a computerized modeling system that "guides the user through the object-oriented design process." The invention described by Mutschler is useful for interchanging metadata between modeling tools and metadata repositories in distributed heterogeneous environments. The present invention also discloses a software tool. However, the software tool of the present invention as specifically claimed is novel and non-obvious over the cited references.

Specifically, Applicant asserts that Carpenter-Smith does not disclose the method of the current invention because the present method is almost entirely automated as now reflected in the currently amended claims. On the other hand, Carpenter-Smith discloses an interactive software tool that requires extensive input from the user. Moreover, there is no suggestion, teaching or motivation for combining Mutschler with Carpenter-Smith to come up with the present invention. In addition, the references cited but not applied, alone or in combination fail to contain any teaching or suggestion of methods and systems of the present invention.

CONCLUSION

In view of the foregoing, claims 1-70 constituting the claims pending in the application, are submitted to be fully patentable and in allowable condition to address and overcome the rejections.

If any issues remain outstanding, incident to the allowance of the application, Examiner Nahar is respectfully requested to contact the undersigned attorney at (919)-664-8222 or via email at jriang@trianglepatents.com to discuss the resolution of such issues, in order that prosecution of the application may be concluded favorably to the applicant.

Respectfully submitted,

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